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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,922	04/19/2004	Carlos A. Castro	A2006-700610	1022

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LOWRIE, LANDO & ANASTASI
RIVERFRONT OFFICE
ONE MAIN STREET, ELEVENTH FLOOR
CAMBRIDGE, MA 02142

EXAMINER

GITOMER, RALPH J

ART UNIT	PAPER NUMBER
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1657

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,922

Applicant(s)

CASTRO ET AL.

Examiner

Ralph Gitomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election with traverse of Group I, claims 1-13, in the reply filed on 9/11/06 is acknowledged. The traversal is on the ground(s) that all the Groups contain a common feature. This is not found persuasive because a common feature is not a criterion regarding restriction. The Groups are distinct inventions for the reasons given.

The requirement is still deemed proper and is therefore made FINAL.

Please inform the examiner of any related applications, pending, allowed or abandoned. A reference has been supplied and considered by Pyrotell entitled "Limulus Amebocyte Lysate" but no date is provided for the reference. It is presumed to be prior to 1988 because written on the face of the document is "product discontinued in 1988."

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/897,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims include a transfer instrument in the kit and the claims of '979 do not include a transfer instrument.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Khan and Pyrotell.

Khan (4,067,776) entitled "Method for Differential Diagnosis of Meningitis with a LAL Test" teaches in column 5 last paragraph, a kit with pyrogen and endotoxin free vessels including a positive control vessel and a test vessel, one containing LAL and the other endotoxin. And endotoxin free transfer means is provided. In column 6 lines 42-45, the vessels may be test tubes of 10 x 75 mm. In column 10 lines 25-39, the sensitivity of LAL was pre-standardized and the endotoxin was diluted to a known concentration. See the claims.

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Pyrotell (LAL) by Assoc. of Cape Cod teaches on page 2, reagents are provided in separate vials where the first contains freeze dried LAL and the sensitivity of the product is marked on the package label, and a positive control containing endotoxin that has confirmed standards on the label. On page 3 all glassware and water is made pyrogen free. On page 4 pipettes are provided.

All of the claimed features are taught by each of the above references for the same function as claimed.

Regarding the quantity of material in each container and the size of the containers, no patentability is seen in the claimed quantities or test tube sizes. Regarding claim 12 directed to written directions, and claim 13 directed to a written certificate of analysis, it is well known in the kit art to label the kit and the components of the kit as shown in the cited references.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1 and all occurrences, "pre-certified" is queried as to when it is certified before what and what it is certified for. That a compound would positively react would be required for the invention to work. No patentability is lent to old compounds that have a certificate or label regarding sensitivity, reactivity or other characteristics. Claim 3 is not understood where the quantity of endotoxin is described as two times the sensitivity.

The abstract of the disclosure is objected to because it is not directed to the presently claimed invention. Correction is required. See MPEP § 608.01(b).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Novitsky (US 2005/0048655 A1) is a related application that is now abandoned.

Wainwright (6,222,021) teaches endotoxin sensitivity.

Loverock (5,998,389) teaches endotoxin sensitivity.

Romaschin (5,804,370) teaches in column 19 endotoxin free pipettes and positive endotoxin controls.

Bosnic (Pharmacia) entitled "Endotoxin Detection (LAL Test)", English translation ordered but not yet available, teaches in the abstract, the gel clot LAL test. On page 87 the positive control has two lambda concentration of endotoxin.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ralph Gitomer
Primary Examiner
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